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PATENT
Atty. Docket: 066603.0122

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
)
Scott A. MOSKOWITZ et al.) Attention: BOX MISSING PARTS
)
Application Number: 09/456,319)
)
Filed: December 8, 1999)
)
For: Z-TRANSFORM IMPLEMENTATION OF)
DIGITAL WATERMARKS)



PETITION UNDER 37 CFR §1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner to permit the filing of the present application under 37 C.F.R. §1.47(a) since one of the joint inventors, Marc Cooperman, has not signed a declaration, an assignment or a verified small entity statement for the present application.

An affidavit of Floyd B. Chapman outlining the efforts that were made to secure Mr. Cooperman's signature on a declaration for the above-referenced patent application is submitted in support of this Petition. Mr. Cooperman has moved from his last known address and no forwarding address is known. To this date, Mr. Cooperman has not signed a declaration or declared whether he will do so in the future.

In the past, Mr. Cooperman has refused to accept communications from Floyd Chapman, who

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had forwarded for Mr. Cooperman's execution, a similar declaration, assignment, and small entity for a different patent application. (See U.S. Patent Application No. 09/281,279).

Further, on January 7, 2000, Mr. Cooperman filed a complaint in the United States District Court for the Southern District of Florida, Miami Division, against Scott Moskowitz, The Dice Company, and Blue Spike Company. The complaint alleged that Mr. Cooperman resides in Maplewood, New Jersey, but did not disclose an address.

Applicants submit that Mr. Cooperman's actions constitute either A) a refusal to sign the application in accordance with 37 C.F.R. §1.47(a) or B) unavailability of an inventor in accordance with 37 C.F.R. §1.47(a). In order to respond to the outstanding Notice to File Missing Parts without any additional extension of time fees being due, Applicants believe that filing this petition is necessary to prevent a potential loss of rights.

Mr. Cooperman's last known address is as follows: 2929 Ramona, Palo Alto, California 94308, though a recently filed complaint alleges that Mr. Cooperman resides in Maplewood, New Jersey.

Attached is a copy of the Joint Declaration signed by Scott Moskowitz, who signed on his own behalf and on behalf of Mr. Cooperman as set forth in 37 C.F.R. § 1.64 and MPEP § 409.03(a). Also concurrently filed herewith is a Declaration of Floyd B. Chapman stating the facts surrounding the non-signature of Mr. Cooperman for above-referenced patent application.

U.S. Appl. No. 09/2281,279
Applicant: Scott A. MOSKOWITZ et al.

A check in the amount of \$130.00 is enclosed to cover the fee required under 37 C.F.R. §§ 1.47(a) and 1.17(h). If any variance exists between the amount enclosed and the amount due, please charge applicant's representative's Deposit Account No. 02-0375.

Respectfully submitted,

BAKER BOTTS, L.L.P.

Dated: March 17, 2000

By:



Floyd B. Chapman
Registration No. 40,555

Baker Botts, L.L.P.
1299 Pennsylvania Avenue, N.W.
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In re Patent Application of:)
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DECLARATION BY FLOYD B. CHAPMAN IN SUPPORT OF A
PETITION TO MAKE APPLICATION UNDER 37 C.F.R. § 1.47(a)


This declaration of Floyd B. Chapman is made as to facts relied upon to establish the diligent effort made to secure the execution of a Joint Declaration by one of the joint inventors, namely, Marc Cooperman, for the above-captioned patent application.

1. I am an attorney with the law firm of Baker Botts, LLP, and I am charged with representing Wistaria Trading, Inc., ("Wistaria") in the prosecution of the above captured patent application (the "Application"), in which Scott A. Moskowitz and Marc Cooperman are named inventors.
2. By virtue of a written assignment of rights from Inventor Scott A. Moskowitz, Wistaria has a proprietary interest in the Application.
3. It was determined that in order to best protect the rights of all interested parties, the Application had to be filed on or before December 8, 1999.
4. Inventor Scott A. Moskowitz filed the Application, with an unexecuted declaration, on December 8, 1999, a date that was after payment of the Issue Fee in the parent application number 08/772,222, but prior to issuance of the patent.

5. In anticipation of receiving a Notice To File Missing Parts, I forwarded via Federal Express copies of the Application, the Joint Declaration, an Assignment, and a small entity declaration, identifying the continuing prosecution application to Mr. Cooperman in a letter dated December 29, 1999 (Exhibit A) requesting that Mr. Cooperman execute the documents.
6. I sent copies to an address which I believed to be his current address, as I had previously sent correspondence to the same address on August 13, 1999, which correspondence Mr. Cooperman refused to accept.
7. On ~~December 31, 1999~~, Federal Express returned the package to me because Mr. Cooperman had "moved, [leaving] no forwarding address."
8. On January 7, 2000, Mr. Cooperman filed a complaint in the United States District Court for the Southern District of Florida, Miami Division, against Scott Moskowitz, The Dice Company, and Blue Spike Company. The complaint alleged that Mr. Cooperman resides in Maplewood, New Jersey, but did not disclose an address. As I also represent Mr. Scott Moskowitz in certain other matters, I can no longer communicate with Mr. Cooperman because of the pending litigation. Nonetheless, based upon the history between Mr. Cooperman and Mr. Moskowitz, I believe that any attempted communication would be met with the same response which I received in August of 1999, namely, that Mr. Cooperman would refuse to accept any such attempted communication.
9. Inventor Scott A. Moskowitz has executed a copy of the Joint Declaration, which is being filed herewith.

10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful and false statements may jeopardize the validity of the application or any patent issued thereon.

Date: March 17, 2000



Floyd B. Chapman, Esq.

AUSTIN
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TELEPHONE: (202) 639-7700
FACSIMILE: (202) 639-7890

December 29, 1999

Via FedEx

PRIVILEGED AND CONFIDENTIAL

Mr. Marc Cooperman
2929 Ramona
Palo Alto, CA 94308

RE: U.S. Patent Application No. 09/456,319
"Z-Transform Implementation of Digital Watermarks"
Our Reference: 066603.0122

Dear Mr. Cooperman:

I represent Wistaria Trading, Inc., which is the assignee of all rights which The Dice Company has in and to the above identified patent application. I understand that you are identified as an inventor in the above referenced application which is a continuation of another application, U.S. patent application number 08/772,222, filed December 20, 1996. I also understand that you are under an obligation to assign your rights in the above identified application to The Dice Company. As The Dice Company has assigned all rights to this application to Wistaria Trading, Inc., your obligation to assign your rights to The Dice Company would obligate you to assign your rights to Wistaria Trading, Inc.

I therefore request you to execute the following documents and have them returned to me on or before **January 15, 2000**:

1. Assignment of application to Wistaria Trading, Inc.;
2. Small Entity Statement as an independent inventor; and
3. Declaration supporting inventorship.

I have enclosed a return Federal Express envelope addressed to my attention for your convenience in returning the signed and dated documents. If we do not hear from you by **January 15, 2000**, we will proceed without your assistance.

Thank you for your cooperation in this matter. If you have any questions, please do not hesitate to contact me.

Sincerely,


Floyd B. Chapman

FBC/eab
Enclosures

ASSIGNMENT

WHEREAS, I, Marc Cooperman, residing at 2929 Ramona, Palo Alto, California, 94308, have invented certain new and useful improvements in:

Z-TRANSFORM IMPLEMENTATION OF DIGITAL WATERMARKS

described in an application for United States Letters Patent filed on December 8, 1999, and accorded Application No. 09/456,319;

AND, WHEREAS, Wistaria Trading, Inc., a corporation organized under the laws of Florida, located at 16711 Collins Avenue, #2505, Miami, Florida, 33160 (hereinafter "ASSIGNEE"), is desirous of acquiring certain rights thereunder;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, its successors, assigns and legal representatives, my entire right, title and interest in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to said improvements, said United States application, any other United States applications, including provisional, divisional, renewal, substitute, continuation, reexamination and reissue applications, based in whole or in part on said United States application or in whole or in part on said improvements, any foreign applications, including international and regional applications, based in whole or in part on any of the aforesaid United States applications or in whole or in part on said improvements, and in and to any and all letters patent, including extensions thereof, of any country which have been or may be granted on any of the aforesaid applications or on said improvements or any parts thereof;

AND I hereby agree for myself and my heirs, executors and administrators, to execute without further consideration any further documents and instruments which may be necessary, lawful and proper in the prosecution of said above-referenced application or in the preparation or prosecution of any continuing, substitute, divisional, renewal, reexamination or reissue application or in any amendments, extensions or interference proceedings, or other applications for patents of any region or country, that may be necessary to secure to ASSIGNEE its interest and title in and to said improvements or any parts thereof, and in and to said several patents or any of them;

AND I hereby covenant for myself and my legal representatives, and agree with said ASSIGNEE, its successors and assigns, that I have granted no right or license to make, use or sell said improvements, to anyone except said ASSIGNEE, that prior to the execution of this deed, my right, title and interest in said improvements had not been otherwise encumbered, and that I have not and will not execute any instrument in conflict therewith;

AND I do hereby authorize and request the United States Commissioner of Patents and Trademarks to issue any and all letters patent which may be granted upon said United States applications, or upon said improvements or any parts thereof when granted, to said ASSIGNEE.

IN WITNESS WHEREOF, I have hereunto set my hand and seal.

Date

Marc Cooperman

County of _____

)

) ss:

State of _____

)

On this _____ day of _____, 2000, before me a Notary Public in and for the County and State aforesaid, personally appeared _____, to me known and known to me to be the person of that name, who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(SEAL)

Notary Public

My Commission Expires _____

Attorney Docket No.: 066603.0122

Inventor: Marc Cooperman

Appl. No.: 09/456,319

Title: Z-TRANSFORM IMPLEMENTATION OF DIGITAL WATERMARKS

**VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY
STATUS (37 CFR 1.9(c) AND 1.27(b)) - INDEPENDENT INVENTOR**

As a below named inventor, I hereby declare that I qualify as an independent inventor as defined in 37 CFR 1.9(c) for purposes of paying reduced fees under section 41 (a) and (b) of Title 35, United States Code, to the Patent and Trademark Office with regard to the invention entitled **Z-TRANSFORM IMPLEMENTATION OF DIGITAL WATERMARKS** described in

(check one) ☐ the specification filed herewith

☒ application serial no. 09/456,319 .filed December 8, 1999

☐ patent no. _____ .issued _____

I have not assigned, granted, conveyed or licensed and am under no obligation under contract or law to assign, grant, convey or license, any rights in the invention to any person who could not be classified as an independent inventor under 37 CFR 1.9(c) if that person had made the invention, or to any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

Each person, concern or organization to which I have assigned, granted, conveyed, or licensed or am under an obligation under contract or law to assign, grant, convey, or license any rights in the invention is listed below:

(check one) ☐ no such person, concern, or organization
☒ persons, concerns or organizations listed below*

*NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27)

NAME Wistaria Trading, Inc.

ADDRESS 16711 Collins Avenue, #2505, Miami, Florida 33160

☐ INDIVIDUAL ☒ SMALL BUSINESS CONCERN ☐ NONPROFIT ORGANIZATION

NAME _____

ADDRESS _____

☐ INDIVIDUAL ☐ SMALL BUSINESS CONCERN ☐ NONPROFIT ORGANIZATION

NAME _____

ADDRESS _____

☐ INDIVIDUAL ☐ SMALL BUSINESS CONCERN ☐ NONPROFIT ORGANIZATION

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee of any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Marc Cooperman
NAME OF INVENTOR

SIGNATURE OF INVENTOR

DATE

Baker & Botts, L.L.P.
The Warner, Suite 1300
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2400